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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,910	04/26/1999	NORIYOSHI SONETAKA	Q54131	2573

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EXAMINER

WEST, LEWIS G

ART UNIT	PAPER NUMBER
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2618

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/298,910

Applicant(s)

SONETAKA, NORIYOSHI

Examiner

Lewis G. West

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 16, 18-22 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 16, 18-22 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments with respect to claims 10, 16 and 18-22, 25-28 have been considered but are moot in view of the new ground(s) of rejection. Applicant has substantially changed the content of the claims and therefore this action is made FINAL and prosecution is CLOSED.

Applicant argues a statement made in a response to arguments in the Final rejection, which is not responsive to the most recent office action and relates to a claim and a rejection which are no longer pending.

Further one of ordinary skill in the art knows, and would have known at the time of the rejection that a mobile switching center exchanges telephone signals and is therefore a telephone exchange. It was in a response to argument and not in the rejection, there was no "official notice" taken therefore these statements by applicant is moot, as while MPEP states that an Official Notice may be challenged and evidence required there is no reliance on this statement as an Official Notice for a USC 103 rejection and therefore applicant's citation of MPEP 2144.03 is completely irrelevant to the argued rejection. The examiner is allowed to point out an inherent fact in arguments, in this case a Mobile Switching Center is inherently and by definition a telephone exchange, and this is known to anyone with a basic knowledge of cellular systems.

However, while not required, a basic definition showing this to be true is provided (See DORNAN, The Essential Guide to Wireless Communications Applications, Glossary entry for MSC) in order to prevent any further dispute over basic facts. It states that and MSC is "The telephone exchange that switches voice calls to and from a mobile network."

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Further applicant has no support for sending digits to a telephone exchange each time they are dialed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 16, 18-22 and 25-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has no support for sending transmitting a dialing signal to a telephone exchange each time the dialing signal is generated, as in claims 10 and 16, and therefore the claims that depend therefrom. This is new matter and MUST be removed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10, 16, 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Sandler (US 5,983,117).

Regarding claim 10, Sandler discloses a radio access system comprising: means for producing dialing signals comprising a telephone set having a dial pad with keys, wherein a dialing signal is generated each time a key of said dial pad is pushed a telephone exchange (MSC, 140) in radio communication with said means for producing dialing signals through a base station (131); means for transmitting the dialing signal to said telephone exchange each time the dialing signal is generated; and, means for deciding whether a received dialing signal represents a final digit of a dialed telephone number or not (DCP,160). (Col. 8- col. 9)

Regarding claim 16, Sandler discloses a radio access method comprising the steps of: producing a single digit dialing signal when a key of a dial pad is pushed; transmitting each dialing signal from a subscriber terminal and through a base station control station to a telephone exchange each time the dialing signal is produced; and deciding whether a received single digit dialing signal represents a final digit of a dialed telephone number or not. (Col. 8 -col. 9)

Regarding claim 19, the combination of Bilgic and Sandler discloses the radio access system according to claim 10, wherein said means for deciding comprises an inter-digit timer and a means for determining that a dialing signal has not been received for a fixed period of time. (Sandler col. col. 8 line 53-Col. 9 line 5)

Regarding claim 20, Sandler discloses the radio access system according to claim 10, wherein said means for deciding comprises an inter-digit timer and a means for determining that a dialing signal has not been received for a variable period of time. (Sandler col. col. 8 line 53-Col. 9 line 5)

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Regarding claim 21, Sandler discloses the radio access system according to claim 10, wherein said means for deciding comprises a means for counting a fixed number of said dialing signals. (Sandler Col. 9 lines 9-26)

Regarding claim 22, Sandler discloses the radio access system according to claim 10, wherein said means for deciding comprises a means for counting a variable number of said dialing signals. (Sandler Col. 9 lines 9-26)

Claims 10, 16, 18-22 and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Bilgic (US 5,884,148).

Regarding claim 10, Bilgic discloses a radio access system comprising: means for producing dialing signals comprising a telephone set having a dial pad with keys, wherein a dialing signal is generated each time a key of said dial pad is pushed a telephone exchange (Col. 10 line 22-col. 11 line 24) in radio communication with said means for producing dialing signals through a base station (112); means for transmitting the dialing signal to said telephone exchange (120) each time the dialing signal is generated (Col. 11); and, means for deciding whether a received dialing signal represents a final digit of a dialed telephone number or not. (Col. 8 line 21-42)

Regarding claim 16, Bilgic discloses a radio access method comprising the steps of: producing a single digit dialing signal when a key of a dial pad is pushed (Col. 10 line 22-col. 11 line 24); transmitting each dialing signal from a subscriber terminal and through a base station control station to a telephone exchange each time the dialing signal is produced; and deciding

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whether a received single digit dialing signal represents a final digit of a dialed telephone number or not. (Col. 8 lines 21-42)

Regarding claim 18, Bilgic discloses the radio access system according to claim 10, wherein said base station opens a communications channel after deciding that a received dialing signal represents the final digit of the dialed telephone number. (Bilgic col. 8 line 21-42)

Regarding claim 19, Bilgic discloses the radio access system according to claim 10, wherein said means for deciding comprises an inter-digit timer and a means for determining that a dialing signal has not been received for a fixed period of time. (Bilgic col. 8 line 21-42)

Regarding claim 21, Bilgic discloses the radio access system according to claim 10, wherein said means for deciding comprises a means for counting a fixed number of said dialing signals. (Bilgic col. 8 line 21-42)

Regarding claim 22, Bilgic discloses the radio access system according to claim 10, wherein said means for deciding comprises a means for counting a variable number of said dialing signals. (Bilgic col. 8 line 21-42)

Regarding claim 25, Bilgic discloses the radio access system according to claim 10, wherein a private branch exchange is coupled to said telephone exchange. (Col. 21 lines 46-57)

Regarding claim 26, Bilgic discloses the radio access system according to claim 10, wherein said base station includes means for deciding (Col. 8 lines 21-42).

Regarding claim 27, Bilgic discloses the radio access system according to claim 10, wherein said system further comprises a base station control station (113) for controlling said base station (112), and said base station includes said means for deciding (Col. 8 lines 21-42).

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Regarding claim 28, Bilgic discloses the radio access system according to claim 10, wherein said system further comprises a terminal (102) that is connectable to said base station via a radio link (Figure 1), and said subscriber terminal includes said means for deciding. (Col. 1 lines 46-67)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. As stated above, DORNAN (DORNAN, The Essential Guide to Wireless Communications Applications, Glossary entry for MSC, page 393) shows that one of ordinary skill in the art considers a mobile switching center to be a telephone exchange.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 571-272-7859. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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